

### **Remarks**

The Examiner rejected claims 1-2 under 35 U.S.C. §103(a) as being unpatentable over Tachibana, et al., U.S. Patent No. 6,688,005 (Tachibana) in view of Becker, et al., U.S. Patent No. 4,337,563 (Becker). It is respectfully submitted that claims 1, 2 and 4-11 are patentable over the combination of Tachibana and Becker, claims 4-11 having been indicated as being patentable.

Specifically, claim 1 recites that the receiving passage has a peripheral groove on an inside periphery for receiving the secondary bearing element.

The Examiner recognizes that the receiving passage with a peripheral groove on an inside periphery is not disclosed or suggested by Tachibana, alleging, however, that such a receiving passage is disclosed in Becker. The Examiner asserts that it would have been obvious to provide such a receiving passage in Tachibana. Applicant respectfully disagrees with this assertion.

Applicant respectfully submits that Becker is not a pertinent reference. Becker relates to manufacturing of multiple drill pipes and, in particular, to assembling of such pipes. The present invention and Tachibana relate to the field of saber saws. There is no reason for one involved in solving problems associated

with saber saws to look for solution of these problems to the field of multiple drill pipes.

Further, the object of Tachibana is to provide a long-life silent saber saw. The object of Becker is to simplify repair and/or replacement of the connection of the inner and outer pipes. It is unclear how the Becker solution would contribute to achieving the object of Tachibana.

The case law holds that in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Becker, which relates to a multiple drill pipe, is not in the field of the applicant endeavor, namely, a power tool, in particular a saber saw. Neither is Becker pertinent to a particular problem the present invention solves, namely, providing an increased operating comfort and low maintenance expenditure.

However, even assuming, *arguendo*, that Becker is a pertinent reference, a *prima facie* case of obviousness has not been made.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that at least the first element of *prima facie* obviousness has not been established.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992 (footnote omitted) (emphasis in original)). See also In re Sernaker, 217 U.S.P.Q. 1,6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988); IU, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in Tachibana and/or Becker for their combination.

A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01 relying on Ex Parte Levensgood, 28 U.S.P.Q.2d 130 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or inference in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” *Id.* At 1301 (emphasis in original). No such evidence is presented in the Office Action. It is noted that the case law rejects the “common knowledge” of one skilled in the art as a substitute for specific evidence that the prior art suggests the invalidating combination or references. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

The Office Action asserts that it would have been obvious to provide a groove on the inside periphery of the receiving passage in Tachibana for preventing the secondary element from sliding along the housing.

In Becker, several O-rings 86, 88, 90 are mounted in sets of corresponding inner and outer grooves to axially secure the inner pipe relative to the outer pipe

with a possibility of a relative rotation of the pipes. However, in Tachibana, the cylindrical resilient member 30 is already axially secured by bolts 12. Therefore, there is no need for an additional axial fixing of the resilient member by providing a peripheral groove for receiving the second bearing element. Providing additional grooves for receiving the radial projections 31 of the resilient member would only increase manufacturing costs without any added benefits. Moreover, such grooves would limit the swinging movement of the resilient member about the axis of the bolt 12, but the swinging movement is rather important for the bearing function of the resilient member.

The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record is any evidence, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrive at the claimed invention. *In re Jones* 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

*In re Fritch*, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the *In re Fritch* holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Spinnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

It is respectfully submitted that obviousness of the present invention over the combination of Tachibana and Becker can be gleaned only from a hindsight reconstruction.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in *Uniroyal v. Redkin-Willey*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

Nothing in the prior art suggests the desirability of the combination set forth in the Office Action. The same Court further stated:

. . . it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention.”

In view of the above, it is respectfully submitted that the combination of Tachibana and Becker would not be obvious and the present invention, as defined in Claim 1 is patentable over said combination.

Claim 2 depends on claim 1 and is allowable as being dependent on an allowable subject matter.

Claims 4-11 were found to be allowable.

## CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

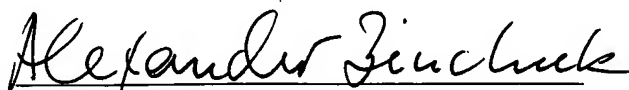


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